PAPER

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09/526,031	03/15/2000	Jonathan J. Hull	74451.P114	9293

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EXAMINER
SMITH, PETER J

ART UNIT	PAPER NUMBER
2176	5

DATE MAILED: 08/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PRG

Office Action Summary	Application No.	Applicant(s)	
	09/526,031	HULL ET AL.	
	Examiner	Art Unit	
	Peter J Smith	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 March 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 March 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This action is responsive to communications: application filed on 03/16/2000, IDS filed on 12/17/2000.

2. Claims 1-9 are pending in the case. Claims 1, 6, and 8 are independent claims.

Information Disclosure Statement

3. The listing of Gormish et al., US 5,337,362 in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 37 is rejected under 35 U.S.C. 102(b) as being anticipated by Covington et al., US 5,524,193 published 06/04/1996.

Regarding independent claim 37, Covington discloses creating a document to be used with a multimedia annotation in col. 2 lines 39-41 and creating a multimedia annotation in col. 2

lines 49-50. Covington also discloses storing an image of the document and the multimedia annotation in col. 4 lines 8-11 and combining the document and the multimedia annotation to form a multimedia document in col. 2 lines 52-55.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-4, 7-8, 13-16, 19-20, 25-28, 31-32, and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Covington et al., US 5,524,193 published 06/04/1996 in view of Gormish et al., US 5,337,362 published 08/09/1994.

Regarding independent claim 1, Covington teaches creating a multimedia annotation for a document and combining the document with the multimedia annotation to form a multimedia document in col. 2 lines 39-41. What Covington does not teach is that the annotated document may be paper. Gormish does teach adding digital data into a paper document in col. 2 lines 8-40 and col. 3 lines 7-25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gormish into Covington to create the claimed invention. It would have been obvious and desirable to use the ability to place digitally encoded data onto a paper document taught by Gormish and use the said ability to implement the annotation method of

Covington so that the user could have had increased freedom to read the document in either paper form or electronic form.

Regarding independent claim 13, Covington teaches creating a multimedia annotation for a document and combining the document with the multimedia annotation to form a multimedia document in col. 2 lines 39-41. What Covington does not teach is that the annotated document may be paper. Gormish does teach adding digital data into a paper document in col. 2 lines 8-40 and col. 3 lines 7-25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gormish into Covington to create the claimed invention. It would have been obvious and desirable to use the ability to place digitally encoded data onto a paper document taught by Gormish and use the said ability to implement the annotation program on machine-readable medium of Covington so that the user could have had increased freedom to read the document in either paper form or electronic form.

Regarding independent claim 25, Covington teaches a computer system comprising a data storage device, a processor coupled to the storage device, and inherently comprising a bus in col. 3 line 63 – col. 4 line 20. Covington also teaches creating a multimedia annotation for a document and combining the document with the multimedia annotation to form a multimedia document in col. 2 lines 39-41. What Covington does not teach is that the annotated document may be paper. Gormish does teach adding digital data, which could be annotations, into a paper document in col. 2 lines 8-40 and col. 3 lines 7-25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gormish into Covington to create the claimed invention. It would have

been obvious and desirable to use the ability to place digitally encoded data onto a paper document taught by Gormish and use the said ability to implement the annotation computer system of Covington so that the user could have had increased freedom to read the document in either paper form or electronic form.

Regarding dependent claims 2, 14, and 26, which are dependent on claims 1, 13, and 25 respectively, Covington and Gormish teach the limitations of claims 1, 13, and 25 as explained above. Covington does not teach a multimedia annotation represented as a bar code printed on a multimedia document. Gormish does teach a multimedia annotation represented as a bar code printed on a multimedia document in col. 1 lines 45-66 and also discloses a more advanced form of digital representation on paper in Fig. 2.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gormish into Covington to create the invention as claimed. It would have been obvious and desirable to use a bar code to represent the multimedia annotation on the multimedia document because bar code scanners were well known and inexpensive and would have made the invention economically attractive for interpreting the multimedia data.

Regarding dependent claims 3, 15, and 27, which are dependent on claims 2, 14, and 26 respectively, Covington and Gormish teach the limitations of claims 2, 14, and 26 as explained above. Covington teaches a multimedia annotation which encodes an audio sound in the abstract.

Regarding dependent claims 4, 16, 28, and 40, which are dependent on claims 1, 13, 25, and 38 respectively, Covington and Gormish teach the limitations of claims 1, 13, 25, and 38 as explained above. Covington teaches a location indicator associated with the multimedia

annotation is placed on the multimedia document, wherein the location indicator indicates where the multimedia annotation can be retrieved and played in col. 2 lines 39-55.

Regarding dependent claims 7, 19, and 31, which are dependent on claims 1, 13, and 25 respectively, Covington and Gormish teach the limitations of claims 1, 13, and 25 as explained above. Covington does not teach that the multimedia document is a paper document. Gormish does teach adding digital data into a paper document which could be the combined multimedia document in col. 2 lines 8-40 and col. 3 lines 7-25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gormish into Covington to create the claimed invention. It would have been obvious and desirable to use the paper document taught by Gormish and use said document to implement the multimedia document of Covington so that the user could have had increased freedom to read the document in either paper form or electronic form.

Regarding dependent claims 8, 20, and 32, which are dependent on claims 1, 13, and 25 respectively, Covington and Gormish teach the limitations of claims 1, 13, and 25 as explained above. Covington teaches combining the image of the paper document and the multimedia annotation to form a compound multimedia document in col. 2 lines 53-55. Covington also teaches storing the image of the document and multimedia annotation in col. 4 lines 8-11.

What Covington does not explicitly teach is generating an image of the paper document, but it was very well known to all of ordinary skill in the art at the time of the invention how to generate an image of a paper document. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the general knowledge of the art to modify

Covington such that paper multimedia documents could have been scanned into the computer system so that the user would have could have had increased freedom to read the document in either paper form or electronic form.

Regarding dependent claim 38, which is dependent on claim 37, Covington teaches the limitations of claim 37. Covington teaches creating a multimedia annotation for a document and combining the document with the multimedia annotation to form a multimedia document in col. 2 lines 39-41. What Covington does not teach is that the annotated document may be paper. Gormish does teach adding digital data into a paper document in col. 2 lines 8-40 and col. 3 lines 7-25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gormish into Covington to create the claimed invention. It would have been obvious and desirable to use the ability to place digitally encoded data onto a paper document taught by Gormish and use the said ability to implement the annotation method of Covington so that the user could have had increased freedom to read the document in either paper form or electronic form.

Regarding dependent claim 39, which is dependent on claim 38, Covington and Gormish teach the limitations of claim 38. Covington does not teach a multimedia annotation represented as a bar code printed on a multimedia document. Gormish does teach a multimedia annotation represented as a bar code printed on a multimedia document in col. 1 lines 45-66 and also discloses a more advanced form or digital representation on paper in Fig. 2.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gormish into Covington to create the invention as claimed. It would have

been obvious and desirable to use a bar code to represent the multimedia annotation on the multimedia document because bar code scanners were well known and inexpensive and would have made the invention economically attractive for interpreting the multimedia data.

8. Claims 5-6, 9-10, 17-18, 21-22, 29-30, 33-34, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Covington et al., US 5,524,193 published 06/04/1996 in view of Gormish et al., US 5,337,362 published 08/09/1994 as applied to claims 1, 8, 13, 20, 25, and 32 above, and further in view of Stern, US 6,572,661 B1 filed 01/11/1999.

Regarding dependent claims 5, 17, 29, and 41, which are dependent on claims 4, 16, 28, and 40 respectively, Covington and Gormish teach the limitations of claims 4, 16, 28, and 40 as explained above. Covington does not teach a location indicator which is a Uniform Resource Locator. Stern does teach a location indicator which is a Uniform Resource Locator in col. 2 lines 2-5 because the link points to an HTML file.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Stern into Covington in view of Gormish to create the claimed invention. It would have been obvious and desirable to use a URL link as the location indicator because this would make the invention compatible with the internet, which would have been a great advantage resulting in extensive compatibility and ease of storing the multimedia files.

Regarding dependent claims 6, 18, 30, and 42, which are dependent on claims 4, 16, 28, and 40 respectively, Covington and Gormish teach the limitations of claims 4, 16, 28, and 40 as explained above. Covington teaches a multimedia annotation which comprises an audio

sound, a video clip, and combination of both the audio sound and the video clip in col. 1 lines 62-64 and col. 2 lines 39-41.

Regarding dependent claims 9, 21, and 33, which are dependent on claims 8, 20, and 32 respectively, Covington and Gormish teach the limitations of claims 8, 20, and 32 as explained above. Covington does not teach a location indicator which is a Uniform Resource Locator. Stern does teach a location indicator which is a Uniform Resource Locator in col. 2 lines 2-5 because the link points to an HTML file.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Stern into Covington in view of Gormish to create the claimed invention. It would have been obvious and desirable to use a URL link as the location indicator because this would make the invention compatible with the internet, which would have been a great advantage resulting in extensive compatibility and ease of storing the multimedia files.

Regarding dependent claims 10, 22, and 34, which are dependent on claims 9, 21, and 33 respectively, Covington, Gormish, and Stern teach the limitations of claims 9, 21, and 33 as explained above. Covington does not teach a location indicator represented as a bar code printed on a multimedia document. Gormish does teach a location indicator represented as a bar code printed on a multimedia document in col. 1 lines 45-66 and also discloses a more advanced form of digital representation on paper in Fig. 2.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Gormish into Covington in view of Stern to create the invention as claimed. It would have been obvious and desirable to use a bar code to represent the location indicator on the multimedia document because bar code scanners were well known and

inexpensive and would have made the invention economically attractive for interpreting the multimedia data.

9. Claims 11-12, 23-24, 35-36, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Covington et al., US 5,524,193 published 06/04/1996 in view of Gormish et al., US 5,337,362 published 08/09/1994 as applied to claim 8, 20, 32, and 38 above, and further in view of Halliday et al., US 5,880,740.

Regarding dependent claims 11, 23, and 35, which are dependent on claims 8, 20, and 32 respectively, Covington and Gormish teach the limitations of claims 8, 20, and 32 as explained above. Covington does not teach sending a multimedia document to a recipient by electronic mail. Halliday does teach sending a multimedia document to a recipient by electronic mail in col. 8 lines 5-28.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Halliday into Covington in view of Gormish to create the claimed invention. It would have been obvious and desirable to send the electronic multimedia document to a recipient so that the user could share the information contained in the document with another person since that is the very purpose of documents and why they exist.

Regarding dependent claims 12, 24, and 36, which are dependent on claims 11, 23, and 35 respectively, Covington and Gormish teach the limitations of claims 11, 23, and 35 as explained above. Covington does not teach a recipient receiving an image of a paper document and a multimedia annotation in the form of a Multipurpose Internet Mail Extension (MIME).

Halliday does teach a recipient receiving an image of a paper document and a multimedia annotation in the form of a Multipurpose Internet Mail Extension (MIME) in col. 8 lines 5-28.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Halliday into Covington in view of Gormish to create the claimed invention. It would have been obvious and desirable to send the electronic multimedia document to a recipient in the form of an electronic mail attachment so that the nature of the multimedia annotations be retained. One of ordinary skill in the art would have known to send multimedia files as attachments in electronic mail.

Regarding dependent claim 43, which is dependent on claim 38, Covington and Gormish teach the limitations of claim 38. Covington does not teach sending the electronic multimedia document to a recipient, wherein the recipient receives the electronic multimedia document in the form of an attachment to an electronic mail. Halliday does teach sending the electronic multimedia document to a recipient, wherein the recipient receives the electronic multimedia document in the form of an attachment to an electronic mail in col. 8 lines 5-28.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Halliday into Covington in view of Gormish to create the claimed invention. It would have been obvious and desirable to send the electronic multimedia document to a recipient in the form of an electronic mail attachment so that the nature of the multimedia annotations be retained. One of ordinary skill in the art would have known to send multimedia files as attachments in electronic mail.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Smith whose telephone number is 703-305-5931. The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

PJS
July 25, 2003

JOSEPH H. FEILD
PRIMARY EXAMINER